

REMARKS

Applicants have above requested reconsideration regarding the premature final action. In accordance with MPEP § 1002, Applicants reserve the right to file a petition within 2 months after receiving the Office's reply to their request for reconsideration.

Claim Status

Claims 1-14, 16-18, 20-21, and 23-46 are pending.

Objections

Claim 45 was objected to.

Rejections

Claims 21 and 32 were rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-13, 32-33, 37-40, and 44-46 were rejected under 35 U.S.C. § 103(a) over Drummond (WO/1998/024041) in view of Larkin (US 5,765,910) and further in view of Vance (US 6,131,874).

Claims 14, 16-18, 20-21, and 23 were rejected under 35 U.S.C. § 103(a) over Drummond in view of Blumstein (US 5,589,855).

Claims 24-31 were rejected under 35 U.S.C. § 103(a) over Drummond in view of Ramachandran (US 6,023,688).

Allowance

Claim 34-36 and 41-43 were not rejected. The Office's inferred allowance of the subject matter therein is appreciated.

As these claims 34-36 and 41-43 do not appear in any statement of rejection, they cannot be considered rejected. USPTO rules require that any claim being rejected be positively listed in a "statement of rejection", which is followed by a body of the rejection. 37 CFR 1.104(c)(2) requires that "each rejected claim" must be clearly specified. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) and MPEP § 706.02(j) also provides evidence that these claims were not legally rejected.

As best understood by Applicants, the Office removed claims 34-36 and 41-43 from any consideration of rejection but unintentionally neglected to remove all mentions thereof from the body of the rejection. If this is not the current situation then Applicants request an affidavit from the Office stating that it has never issued an Office Action containing a rejection where the Examiner removed a claim from a rejection heading but unintentionally neglected to remove remarks thereto from the rejection body. In the absence of such an affidavit then the extraneous language in the Action with regard to claims 34-36 and 41-43 will continue to be disregarded by Applicants as inadvertently referring to claims not rejected. A rejection of claims 34-36 and 41-43 would have to be a new non-final rejection, following withdraw of the current final rejection.

The rejections not based on prior art

At present, the premature final rejection does not permit Applicants to freely amend. Applicants are willing to amend claims 21, 32, and 45 upon removal of the final rejection.

The 35 U.S.C. § 103(a) rejections

Applicants respectfully traverse the rejections. With regard to all of the independent claims, the Action (on page 9, last paragraph) admits that Drummond/Larkin/Vance does not teach or suggest that "data corresponding to at least one characteristic feature and interface parameter is stored in at least one data store". To alleviate this admitted deficiency, the rejection

alleges that in Drummond “data corresponding to user *preferences* are stored in a data store”.

The rejection bases this allegation on the further allegation that “this is how Drummond is able to ‘provide a user with a familiar interface from their home institution at banking machines operated by other institutions.’ (Drummond, page 1, lines 1-5)”.

Determinations of patentability must be based on concrete evidence of record that is capable of judicial review, not mere allegations (which is the current situation). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The Examiner misinterprets Drummond. Where does Drummond disclose using a user preference (which is stored in a data store that is in operative connection with a computer) in order to “provide a user with a familiar interface from their home institution” as alleged? Rather, a text search of Drummond shows that neither “preference” nor “preferences” are mentioned therein.

Furthermore, even if Drummond somehow (for sake of argument) taught storing data corresponding to a user preference in a data store (as alleged by the Office), the admitted deficiency in the combined references would still remain. That is, the combined references still would not teach or suggest the admitted deficiency of stored user data that links *both* a user’s characteristic feature and the user’s interface parameter preference, especially where the user data was stored in a data store in operative connection with a computer.

The Office has not established a *prima facie* case of obviousness. It would not have been obvious to have combined the references as alleged. Even if it were somehow possible (for sake of argument) to combine the references as alleged, the result still would not have produced the recited invention. The record is absent a teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art at the time of the invention to have produced the recited invention. At

best, the rejections are based on attempted hindsight reconstruction of the claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness.

The declaration pursuant to 37 C.F.R. § 1.132

A declaration under 37 C.F.R. § 1.132 is submitted herewith. In contrast to the unsupported opinion of the Examiner (which is relied upon in the rejections), the declaration is from a person with actual knowledge of the relevant art and level of ordinary skill in the art of automated financial transaction apparatuses at the time of the present invention. The declaration further establishes that the relied upon combined references do not provide any teaching, suggestion, motivation, or valid reason to a person of ordinary skill in the art at the time of the present invention to have produced the recited invention. The declaration negates the Office's unsupported allegations that it would have been obvious to a person of ordinary skill in the art at the time of the present invention to have produced the recited features and relationships. The declaration provides further evidence that the recited subject matter would *not* have been obvious to a person of ordinary skill in the art at the time of the invention.

It is well settled that "weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him." *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967). Applicants respectfully submit that the declaration provides such statement.

A declaration statement made by a person who *has* been established in the record as having actual knowledge of the level of ordinary skill in the art at the time of the present invention, legally trumps any contrary opinion made by an Examiner who *has not* been established in the record as a person of ordinary skill in the art at the time of the present invention. Thus, the declaration further refutes the 35 U.S.C. § 103(a) rejections.

Additional comments

MPEP § 706.07(e) makes clear that when a final rejection is withdrawn, all amendments (including declarations) filed after the final rejection (and before its withdraw) are entitled entry. That is, removal of the premature final rejection dated April 2, 2009 results in automatic entry of the Declaration filed herewith.

Conclusion

Applicants respectfully submit that this application is in condition for allowance. The undersigned is willing to discuss any aspect of the Application at the Office's convenience.

Respectfully submitted,



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